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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,998	06/23/2003	Thomas M. Brennan	05871.0010.CNUS03	1644

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EXAMINER

BABIC, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,998

Applicant(s)

BRENNAN ET AL.

Examiner

Christopher M. Babic

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/2/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The first paragraph of the Specification does contain the proper relationship between application 09/686597 and the provisional application 60/158315.

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Claim Objections

1. Claim 14 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In the instant case, Claim 14 fails to limit Claim 1 because a primer releasable by strand separation fails to impart an additional structural element to the invention of Claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 14, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Boles et al (US 6,300,707).

Regarding Claims 1 and 14, Boles et al. teach cleavable oligonucleotide primers that are immobilized to a solid support (*Column 2, Lines 43-60; Column 9, Lines 1-13*). Intended use phraseology such as, "...for performing...", is not considered to further limit the scope of the claims.

Regarding Claim 15, Boles et al. teach photochemical cleavage (*Column 10, Lines 27-36*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rava et al (US 5,545,531) and Boles et al (US 6,300,070).

Regarding Claims 2 and 3, Rava et al. teach supports for processing multiple chip assays (Abstract). In particular, Rava et al. teach the following:

(a) a first solid support; wherein the surface of said comprises a plurality of derivatized areas; wherein one or more primers are immobilized on a derivatized area of said first solid support (*Rava et al. teach a biological chip plate comprising a wafer including a plurality of biological arrays wherein the arrays are a collection of oligonucleotides, at least two of which are different, arranged in a spatially defined manner; Fig 4; Column 2, Lines 62-67; Column 4, Lines 1-19; Column 8, Lines 1-11,*

Rava et al. teach surface immobilized oligonucleotides on a functionalized substrate containing derivatized areas, preferably glass or silica; Fig 8; Column 3, Lines 39-48; Column 9, Lines 29-29 and 36-37).

(b) a second solid support wherein said support comprises a plurality of wells and each well corresponds to a primer for each target nucleic acid (*Rava et al. teach a biological chip plate comprising a plurality of wells, the walls of each well surrounding and enclosing the probe array of a biological array, i.e. corresponding to a primer for each target nucleic acid; Figs 4, 5, and 6; Column 4 Lines 19-25; Column 8, Lines 1-16; Column 8, Lines 40-45).*

Intended use phraseology such as, "...for amplifying...", is not considered to further limit the scope of the claims.

Regarding Claim 4, Rava et al. teach sequencing large quantities of DNA; therefore Rava et al. anticipate pluralities of subsequences of polynucleotides (*Column 11, Lines 43-46).*

Regarding Claim 5, Rava et al. teach glass as a biological chip substrate (*Column 4, Lines 5-7).*

Regarding Claim 6, Rava et al. teach covalent immobilization (*Column 9, Lines 13-67; Column 10, Lines 1-9).*

Regarding Claim 8, Rava et al. teach nucleic acid probes; therefore Rava et al. teach cleavable moieties (i.e. part of the nucleic acid) (*Column 3, Lines 39-67).*

Regarding Claim 10, Rava et al. teach solid support surfaces with Si-OH functionalities; therefore Rava et al. teach hydrophilic areas (*Column 9, Line 50-52).*

Regarding Claim 11, Rava et al. teach an example with a feature size of about 100 microns on a side which would give an array with 10,000 probe addresses per 1 cm²; therefore Rava et al. anticipate a density of derivatized areas of 10 to 10,000 per cm² (*Column 10, Lines 38-40*).

Regarding Claim 12, Rava et al. teach a probe array size of 0.25 mm²; therefore Rava et al. anticipate the size of a derivatized area on a solid support that is between 10⁻³ to 5mm² (*Column 9, Lines 21-24*).

Regarding Claim 13, Rava et al. teach a probe array with 10⁵ features; therefore Rava et al. anticipate a number of derivatized areas on a solid support between 10⁻³ to 500,000 (*Column 9, Lines 21-24*).

Rava et al. teach supports for processing multiple chip assays, but do not teach primers, non-covalent immobilization, or photocleavable moieties.

Regarding Claim 2, Boles et al. teach primers (i.e. 3' terminal ends free to participate in primer extension reactions) immobilized to a solid support (*Column 5, Lines 57-58*).

Regarding Claim 3, Boles et al teach forward and reverse primers immobilized to solid support (*Column 6, Lines 17-22*).

Regarding Claim 7, Boles et al. teach non-covalently attached oligonucleotides to a solid support in a solid phase nucleic acid amplification method (*Column 6, Lines 35-37; Column 7, Lines 9-12*).

Regarding Claim 9 Boles et al. teach photocleavable primers (*Column 9, Lines 65-67 and Column 10, Lines 27-36*).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time of invention to have used the primers of Boles et al. in the Rava et al. biological chip plate. The motivation to do so, provided by Boles et. al, would have been that these primers helped to improve multiplex amplification methods for nucleic acid analysis (*Column 4, Lines 24-29*).

Conclusion

Claims 1-15 are rejected. No claims are free of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Babic whose telephone number is 571-272-8507. The examiner can normally be reached on Monday-Friday 7:00AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TERESA STRZELECKA
PATENT EXAMINER
Teresa Strzelecka

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CMB

A handwritten signature in black ink, appearing to be 'CMB' with a stylized flourish at the end.